

Appln. No. 10/812,806

Attorney Docket No. 9974-077

## II. Remarks

Claims 1-45 are pending in the application. Claims 10, 20, 31 and 43 have been cancelled. Claims 1, 13, 19, 21, 23 and 34 have been amended. No new claims have been added.

### Rejections Under 35 USC § 112

Claim 19 was rejected under 35 USC §112 as having insufficient antecedent basis for the limitation "the invoice number" in relation with claim 13. Applicants have amended claim 19 to cure the antecedent basis concern kindly pointed out by the examiner.

### Rejections Under 35 USC § 102

Claims 1-3, 5-6, 7-9, 11-19, 22-30, 33-36, 38-43, and 45 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent Publication No. 2002/0032612 of Williams (Williams).

These rejections are now moot in light of the claim amendments presented above and the arguments presented below.

### Rejections Under 35 USC § 103

Claims 10, 20, 31 and 43 were rejected under 35 USC §103(a) as being unpatentable over Williams in view of U.S. Patent Publication No. 2004/0172260 of Junger (Junger).

The claims of the present invention are directed to a system and method for a customer to return merchandise to a merchant. Amended claims 1, 13, 23 and 34 now include the limitations of searching the database of returned merchandise to

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determine whether the unwanted merchandise was previously returned and then creating a merchandise return form having the merchandise identifier of the merchandise eligible to be returned based upon the determination previously made. These limitations were originally presented in dependent claims 10, 20, 31 and 43 that are now cancelled.

Williams discloses a computer system that is configured to provide on-line stores a way for ecommerce customers to return merchandise purchased from the on-line store. More specifically, Williams discloses a system and method for a customer to return a product using a merchant return form on which the merchandise to be returned is identified. However, Williams does not disclose determining whether the unwanted merchandise is eligible to be returned by searching the database of returned merchandise to determine whether the unwanted merchandise was previously returned and then creating a merchandise return form having the merchandise identifier of the merchandise eligible to be returned, as now claimed in amended claims 1, 13, 23 and 34.

Junger discloses an electronic registration system for authorizing product returns to reduce the incidence of improper returns. More specifically, the system and method of Junger is focused on minimizing or preventing fraudulent returns by identifying whether a person has purchased a new product with new packaging and then tried to return the new packaging with an old or different product for credit or return. The Junger invention reduces this type of fraud by requiring that the actual product be scanned rather than only the packaging returned with the product. During a product return the Junger system will recognize whether only the packaging serial number has been scanned and prevent acceptance of the return until the actual product is scanned, thus assuring that the actual product not just the

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packaging qualifies for return (see Junger, paragraph 76). Further, the system and method of Junger provides a method for returning merchandise whereby the customer presents the sales receipt at the time of a return, the store associate may compare the serial number on the product with that on the sales receipt. The associate compares the printed serial number with that on the product itself, rather than the serial number on the packaging, to guard against repackaging of an old product in a box for a recently purchased product. If the serial number matches, the return is within an applicable allowable time period and all other return qualifications are met, i.e., no major parts are missing, the return may be accepted (see Junger, paragraph 93).

Junger, as pointed out by the Examiner, provides reports to locate trouble caused by malfunctioning retailer systems or attempted fraud. For example, these reports may include a pass/fail ratio for all returns by a particular retailer over a given time period, duplicate serial numbers may be located and listed, previously registered serial numbers may be flagged, and cross-references may be made between the registration date and the date the product was returned to the manufacturer.

However, Junger does not disclose or suggest utilizing these reports to determine whether the unwanted merchandise is eligible to be returned by searching a database of returned merchandise to determine whether the unwanted merchandise was previously returned. The Junger reports are focused on locating trouble spots and monitoring potential retailer abuse not customer fraud during a return (see Junger, paragraph 90). Moreover, Junger only teaches that a return is accepted (or eligible to be returned) if the serial number on the product matches the invoice, the return is within an applicable allowable time period and no major parts

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are missing (see Junger, paragraph 93). Junger does not mention or suggest determining a product's eligibility to be returned by determining whether a product has been previously returned. In order to establish a prima facie case of obviousness each and every limitation must be found in the applied references. Applicants assert that this burden has not been met for the reasons stated above. Thus, neither Junger nor Williams in combination or taken separately teach or suggest the present invention, as now claimed, in amended claims 1, 13, 23 and 34. Accordingly, Applicants respectfully request allowance of claims 1, 13, 23 and 34.

Claims 4, 21, 32, 37 and 44 were rejected under 35 USC §103(a) as being unpatentable over Williams in view of U.S. Patent Publication No. 2006/0114221 of Walters (Walters).

Walters discloses an interface for a merchandise return system that allows one or more merchants to funnel their returns processing to a central returns processing center. More specifically, Walters teaches that the customer is prompted for information about the merchandise being returned and that the information may be used by the merchant to determine whether to authorize the return. For example, Walter teaches that information may be the reason for the return, whether the package is opened and whether the customer seeks a credit or a replacement. However, nowhere in Walters is it taught or suggested that the merchant determines whether the unwanted merchandise is eligible to be returned by searching a database of returned merchandise to determine whether the unwanted merchandise was previously returned. Thus, Williams, Junger nor Walters in combination or taken separately teach or suggest the present invention, as now claimed, in amended claims 1, 13, 23 and 34.

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With regard to claims 4, 21, 32, 37 and 44 these claims depend from one of claims 1, 13, 23 and 34 and therefore are patentable for at least the same reasons as given above in support of claims 1, 13, 23 and 34. Accordingly, Applicants respectfully request allowance of claims 4, 21, 32, 37 and 44.

### SUMMARY

Pending Claims 1-45 as amended are patentable. Applicants respectfully request the Examiner grant early allowance of these claims. The Examiner is invited to contact the undersigned attorneys for the Applicants via telephone if such communication would expedite this application.

Respectfully submitted,

December 16, 2005  
Date

  
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